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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,616	02/10/2004	Howard Jason Harrison	81328.0003	3389

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EXAMINER

LE, TAN

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/774,616
Filing Date: February 10, 2004
Appellant(s): HARRISON ET AL.

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GROUP 3600

Floyd B. Chapman
David J. Kulik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 22, 2005 appealing from the
Office action mailed October 20, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. The correction is as follows:

A reply and amendment filed in response to the final office action was filed on December 20, 2004. The reply and amendment amended claims 1 and 7 and *canceled claims 3-5, 9-11 and 13-17*. An advisory action mailed on December 30, 2004.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 6-8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Aloisi (US 6,309,016).

(10) Response to Argument

The examiner's response to Appellant's argument mailed on October 10, 2004 is incorporated herein by reference. In the following, the examiner responds to Appellant's arguments in the Appeal brief that has been either addressed or not addressed in the paper mailed October 20, 2004.

The examiner has carefully reviewed Applicant's arguments in the Appeal Brief of December 22, 2005. These arguments have fully considered but they are not persuasive.

Appellant basically contends that it is unreasonable to interpret the content of Aloisi in the way the examiner has to allegedly to anticipate the pending claims for two reasons: First, nothing within the four corners of Aloisi even suggests a figure that can be arranged or sized to accommodate a pair of eyeglasses so that the eyeglass contact each of the arms or appendages as recited in claims 1 and 7; Second, the claims cannot reasonably be interpreted to encompass something as large as the furniture or tables referred to in Aloisi" (page 9, first para)

First, the examiner respectfully contends that the languages as recited in claim 1 or claim 7 such as "wherein the arms or appendages together with the body or torso are *sized to accommodated a pair of a persons or childs eyeglasses so that the eyeglasses contact each of the arms or appendages*" as recited in claim 1 or 7 is merely a recitation intended use that is intended to be employed, defining no positive structure or positive part of the claims by which the claims may be distinguished from the prior art of Aloisi.

With respect to Appellant's argument that nothing within the four corners of Aloisi even suggests a figure that can be arranged or sized in claims 1 and 7. The examiner respectfully submits that nothing in Aloisi also even suggested a figure that cannot be arranged or sized to accommodate a pair of eyeglasses so that the eyeglass contact each of the arms or appendages as recited in claims 1 and 7.

With respect to Appellant's argument that the claims cannot reasonably be interpreted to encompass something as large as the furniture or tables referred to Aloisi. In response the examiner respectfully contends that "large" or "small" are relative concepts. Things may meaningfully be described as "large" or "small", "heavy" or "light", only by relation to other things. It is not all clear simply from reading the element of claims 1 or 7 at what sizes the inventor would concede in order to accommodate a pair of a persons or childs eyeglasses so that the eyeglasses contact each of the arms or appendages. In order to be valid, a patent must not only disclose the invention, it must also do so in a way, which sufficiently defined to put other on notice of the limits of what is claimed. Appellant's arguments appears based on element that is not part of the claim, unclaimed, or undefined elements. It should be noted that it is improper to define elements of the claimed invention/apparatus based on a comparison to unclaimed and undefined elements that are not part of the claim. This creates the situation wherein one instance a device would infringe the claimed subject matter because of its use, thus; the metes and bounds of the claim cannot be properly ascertained. Also as mentioned in the final office action, the examiner has reviewed the specification and found no specific teachings or criticalities about the sizes of the arms or the sizes of the persons childs eyeglasses so that "the eyeglass contact each of the arms or appendages" as recited in claims 1 and 7. The specification was therefore considered not limiting. Therefore arguing "the claims cannot reasonably be interpreted to encompass something as "large as the furniture or table referred to in Aloisi" is unpersuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Tan Le
Patent examiner
March 2, 2006

Conferees :

Robert P. Olszewski
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